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Claims 1-5 and 7 were rejected for allegedly being anticipated by US 6187298 to Kurz et al.

Claims 1-7 were rejected for allegedly being obvious over the combination of DE 19810120 to Fath in view of Kurz.

Claims 1-5 and 7-9 were rejected as allegedly being obvious over US 6309628 to Ansmann in view of Kurz.

The rejections are addressed below in sequence.

Anticipation by Kurz

In response, Applicants respectfully remind the Examiner that anticipation requires that each and every element as set forth in the claim must be found, either expressly or inherently described, in a single prior art reference, and, further, that the absence in the prior art reference of even a single claim element precludes a finding of anticipation. *In re Robertson*, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

Amended claim 1 now recites that the composition comprises green tea extract and a pH no greater than about 6. Kurz does not teach either of these limitations.

Accordingly, Kurz does not anticipate the amended claims, and the rejection should be withdrawn.

Obviousness over Fath in View of Kurz

A. All Claim Limitations are not met by Fath in View of Kurz

To establish a *prima facie* case of obviousness, three basic criteria must be met, one of which is that the prior art reference (or references when combined) must teach or suggest all the claim limitations. *MPEP* § 2143.

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Amended claim 1 now recites that the composition must have a pH that is no greater than 6. There is no express or implied teaching or suggestion of any desired pH range in either Fath or Kurtz. Therefore, the combination of these references cannot reasonably be found to teach or suggest the desirability of any pH, let alone that which is no greater than about 6.

On this basis alone, the obviousness rejection over Fath in view of Kurz should be withdrawn.

Should Examiner contemplate that amended claim 1's pH limitation falls in the category of *routine optimization*, we respectfully bring attention to MPEP 2144.05 section II (Optimization of Ranges). It is clearly set forth therein that "*A particular parameter must first be recognized as a result-effective variable*, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation. *In re Antonie*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977)."

Therefore, because Fath and Kurz do not disclose the importance of pH or any pH ranges, *Antonie* would bar a rejection under the premise of routine optimization.

B. The References do not Supply any Suggestion or Motivation to Support Their Being Combined

Fath discloses green tea- extracts for use in hair care. Example 4 further discloses the addition of benzophenone-4, a UV filter. There is no evidence that Fath discloses any other UV filter or any filters of visible and/or infrared light. Neither has Examiner demonstrated any disclosure in Fath of the desirability or necessity to include filters of visible and/or infrared light.

The importance of this is that, as Kurz discloses, mica/titanium particles are only filters in the infrared and visible range. Therefore, without Fath providing a motivation to specifically modify the green tea extract-containing composition to include any infrared and

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visible light filters, this combination of references is improper, and cannot reasonably provide a basis for a rejection under § 103(a).

Examiner states that mica/TiO₂ are well tolerated, and therefore seems to believe that this is sufficient for motivating the proposed modification. This is not the appropriate legal standard. This merely indicates that Examiner's proposed modification can, in fact, be made. However, the PTO guidelines clearly indicate that this is not sufficient to maintain an obviousness rejection. MPEP § 2143; ("The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990) (Emphasis added)).

In sum, the rejection over Fath and Kurz should be withdrawn because the combined references (1) do not teach each claim limitation, and (2) there is insufficient motivation to combine the references.

C. Ansmann and Kurz do not Teach or Suggest Each Claim Limitation

As indicated above, claim 1 now recites (1) green tea extract and (2) a pH that is no greater than about 6. These limitations are not taught or suggested by the references individually or in combination.

Accordingly, withdrawal of the rejection in view of Ansmann and Kurz is respectfully solicited.

CONCLUSION

Applicants respectfully request allowance of the claims in view of the foregoing amendment and remarks.

All formal corrections have been made as suggested by the Examiner.

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The references have been shown not to teach or suggest each of the limitations in amended claim 1.

Accordingly, withdrawal of the rejections is requested.

Respectfully Submitted,

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MARK UP OF AMENDED CLAIM 1

1. (Amended) An aqueous hair care composition on an aqueous basis, comprising
a) at least one UV-absorbing substance, and
b) at least one mica /titanium dioxide pigment ~~whereby~~ wherein at least 90% by weight thereof ~~of the mica /titanium dioxide pigment comprises~~ have a particle size between about 10 and 250 microns,
c) green tea extract, and
wherein the entire composition has a pH no greater than about 6.
2. (Amended) Hair care composition according to claim 1, wherein 80% to 90% by weight of the pigment ~~consist~~ consisting of mica, and 10% to 20% by weight thereof ~~consist~~ consisting of ~~titan~~ titanium dioxide.
- 4.(Amended twice) Hair care composition according to claim 1, wherein the UV-absorber is selected from at least one of the compounds 4-aminobenzoic acid and the esters and salts thereof, 2-phenyl benzimidazole-5-sulfonic acid and the alkali and amine salts thereof, 4-dimethyl aminobenzoic acid and the esters and salts thereof, cinnamic acid and the esters and salts thereof, 4-methoxy cinnamic acid and the esters and salts thereof, salicylic acid and the esters and salts thereof, 2,4-dihydroxybenzophenone, 2,2',4,4'-tetrahydroxybenzophenone, 2-hydroxy-4-methoxybenzophenone and its 5-sulfonic acid or the sodium salt thereof, 2,2'-dihydroxy-4,4'-dimethoxybenzophenone, 2-hydroxy-5-chlorobenzophenone, 2,2'-dihydroxy-4-methoxybenzophenone, 2,2'-dihydroxy-4,4'-dimethoxy-5,5'-disulfobenzophenone or the sodium salt thereof, 2-hydroxy-4-octyloxybenzophenone, 2-hydroxy-4-methoxy-4'methyl benzphenone, 3-benzylidene campher, 3-(4'-sulfo)-benzylidene bornane-2-one and the salts thereof and/or 3-(4'-methyl benzylidene)-DL-campher.

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7. (Amended twice) Hair care composition according to claim 1, wherein the composition further contains about 0.1% to 5% by weight of at least one amphoteric or zwitterionic surfactant, calculated to the total composition.

8. (Amended twice) Hair care composition according to claim 7, wherein the composition further contains about 0.25% to 2.5% by weight, calculated to the total composition, of at least one betaine.

9. (Amended twice) Hair care composition according to claim 1, wherein the composition further contains about 0.1% to 10% by weight of at least one C₁₂-C₁₈-alkyl amidopropyl ~~amidopropyl~~ dimethyl or diethyl amine.